

Atty. Dkt. No. 10010566-1

REMARKS

This Reply is in response to the Office Action mailed on August 9, 2006 in which claim 12 was objected to and in which claims 1-11 and 13-46 were rejected. With this response, claims 27-29 and 40-41 are canceled; claims 33, 38, 42 and 46 are amended; and claims 47-51 are added. Claims 1-26, 30-39 and 42-51 are presented for reconsideration and allowance.

I. Rejection of Claims 1-11 and 13-46 under 35 USC 103(a) Based upon Tsai and Han

Page 2 of the Office Action rejected claims 1-11 and 13-46 under 35 USC 103(a) as being compatible over Tsai US Patent 6,721,072 in view of Han US Patent Publication 2001/0000979. Claims 27-29 are canceled. Claims 1-11, 13-26 and 30-46, as amended, overcome the rejection based upon Tsai and Han.

A. Claim 1

Claim 1 recites a picture frame scanner which includes an upright frame defining a display area, a transparent retention pane mounted within the frame and spanning the display area, a support back spanning the display area and an image scanning bar. The image scanning bar is mounted in the frame for moving across the display area.

Neither Tsai nor Han, alone or in combination, disclose or suggest a picture frame scanner wherein a scanning bar is mounted within an upright frame while the item being scanned is disposed between a support back and the retention pane. In contrast, scanning module 38 of Tsai is on top of, not within frame 52. This fact is quite evident in Figure 4. In fact, Tsai specifically teaches away from locating scanning module 38 within frame 52 as set forth in column 1, lines 27-36.

Moreover, Tsai appears to require the scanning module 38 to be located on top of frame 52 rather than within frame 52 since Tsai requires the scanning module 38 to face a back of a scanning device 30. To alternatively locate scanning module 38 within frame 52 would destroy

Atty. Dkt. No. 10010566-1

the intended operation of scanning device 30 and would require a complete reconstruction and redesign a scanning device. As noted in MPEP 2143.02, THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE and THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE. Thus, even though Han may disclose a scanning bar within a frame, it would not be obvious to modify Tsai based upon Han to locate its scanning module 38 within frame 52. Accordingly, the rejection of claim one should be withdrawn. Claims 2-11 and 13-25 depend from claim 1 and overcome the rejection for the same reasons.

B. Claim 4

Claim 4 depends from claim 1 and further recites that the scanner is selectively deployable in landscape and portrait orientations.

Neither Tsai nor Han, alone or in combination, disclose or suggest a picture frame scanner that is selectively deployable in landscape and portrait orientations. In rejecting claim 4, the Office Action simply refers to column 2, lines 21-27 of Tsai. This portion of Tsai specifically states:

In FIGS 2 and 3, the sliding guides are placed on the upper and bottom side of the transparent plate 32. However, the sliding guides are also able to be placed on the left and right sides of the transparent plate 32 in this case, a scanning module is there for movable along the upper and bottom side of the transparent plate 32 to scan the document 34 placed on a transparent plate 32.

(Tsai, Column 2, lines 21-27). This portion of Tsai says nothing about the scanning device 30 being selectively deployable in landscape and portrait orientations. Moreover, Figure 4 only illustrates scanner 30 pane supported in a landscape orientation. Nowhere does Tsai indicate that stand 54 is able to support scanning device 30 in any other orientation. Accordingly, the rejection of claim 4 should be withdrawn. Claims 5 and 6 depend from claim 4 and overcome the rejection for the same reasons.

Atty. Dkt. No. 10010566-1

C. Claim 13

Claim 13 depends from claim 1 and further recites a slot for receiving the item to be scanned.

Neither Tsai nor Han disclose a slot for receiving an item to be scanned. In contrast, Tsai requires that item 34 be placed upon plate 32 and that transparent cover 56 positioned over item 34. Nowhere does Tsai disclose a slot.

In rejecting claim 13, the Office Action simply refers to Figure 4. However, nowhere does figure 4 disclose a slot for receiving item 34. Accordingly, the rejection of claim 13 should be withdrawn.

D. Claim 15

Claim 15 depends from claim 1 and recites that the scanner further comprises a display glass mounted within the frame, spanning the display area and spaced apart from the retention pane.

Neither Tsai nor Han disclose such an additional display glass. In rejecting claim 1, from which claim 15 depends, the Office Action characterized transparent plate 32 as the "retention pane" and characterized transparent cover 56 as the "support back." Tsai discloses no other structure that could be characterized as the recited "display glass". The only basis noted in the Office Action for the rejection of claim 15 is the statement "please refer to discussion under claim 1." This is entirely inadequate as the discussion with regard to claim 1 does not characterize any structure as the recited display glass. Obviously, transparent plate 32 cannot be characterized as both the retention pane and the display glass. Accordingly, the Office Action is failed to establish a prima facie case of obviousness. Thus, the rejection of claim 15 is improper to be withdrawn. Claim 16-19 depend from claim 15 and overcome the rejection for the same reasons.

Atty. Dkt. No. 10010566-1

E. Claim 16

Claim 16 depends from claim 15 and recites that the image scanning bar is operably mounted between the retention pane and the display glass.

Neither Tsai nor Han, alone or in combination, disclose a picture frame scanner having a generally upright frame and a scanning bar operatively mounted between the retention pane and the display glass. During scanning in Tsai, transparent cover 56 is placed over transparent plate 32. Scanner module 38 extends across and on top of both plate 32 and cover 56. Thus, scanner module 38 is not located between anything.

Once again, in rejecting claim 16, the Office Action simply makes a statement "please refer to discussion under claim 1." The discussion of claim 1 asserts that scanning module 38 is disposed between support back (56) and retention pane (32). However, this is not correct. The entire purpose of cover 56 is to bear against a face of item 34 to hold item 34 against pane 32 during scanning. At no time is scanning module 30 at Tsai disclose as being between pane 32 and cover 56. Thus, the rejection of claim 16 should be withdrawn.

F. Claims 17-19

Claim 17 depends from claim 15 and further recites that the display glass is treated to at least in part to keep out ambient light during scanning.

Claim 18 depends from claim 17 and recites a display glass is polarized.

Claim 19 depend from claim 15 and recites that the display glass comprises electronically opaquing glass activated by initiation of the scanning.

Neither Tsai nor Han disclose or suggest a display glass that is treated to at least in part keep out ambient light during scanning. (Claim 17). Neither Tsai nor Han disclose or suggest a display glass that is polarized. (Claim 18). Neither Tsai nor Han disclose or suggest a display glass that is electronically opaquing glass activated by initiation of the scanning. (Claim 19).

Atty. Dkt. No. 10010566-1

In rejecting claims 17-19, the Office Action states:

treating and polarizing display glass are well known and routinely implemented in the art (as disclosed in paragraph [0030] of the specification there are various methods of treating display glass one example of which is polarization). Therefore it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include such treatment in combination of Tsai and Han device.

(Office Action, page 5).

This rejection is improper because (1) nowhere to either Tsai or Han provide any suggestion or motivation for treating a display glass and (2) such a modification would render the scanner of Tsai or the scanner of Han in operable for its intended purpose. First, as noted above, the Office Action refers to paragraph [0030] as its alleged basis for modifying Tsai. However, there is no paragraph [0030] in Tsai. Paragraph [0030] of Han reads, "FIG.14 is a front side view of the sixth preferred embodiment of the present invention." Although it is correct that polarization is discussed in Paragraph [0030], this paragraph happens to be found in Applicants' own disclosure. Such reliance on Applicants' own disclosure as a source for motivation for modifying Tsai is improper. The Examiner cannot use Applicant's own disclosure as a blueprint for modifying Tsai.

Second, such a motivation would destroy the intended operation of the scanner of Tsai. In fact, Tsai specifically requires that both plate 32 and cover 56 be transparent. Moreover, since light must be able to pass through plate 32 for scanning transparencies and since light must be able to pass through cover 56 from scanner module 38 during scanning, alternatively treating such panels to reject ambient light would also destroy the operation of Tsai. As noted in MPEP 2143.02, THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE and THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE. Accordingly, the rejection of each of claims 17-19 is improper and should be withdrawn.

Atty. Dkt. No. 10010566-1

G. Claim 20

Claim 20 depends from claim 1 and recites that the support back comprises an electronic display panel for displaying electronic images through the retention pane when an item is not disposed between the support back and the retention pane.

Neither Tsai nor Han, alone or in combination, disclose or suggest a support back that comprises an electronic display panel for displaying electronic images through the retention pane. Nowhere does Tsai disclose anything about electronic images being displayed through transparent plate 32 (characterized as the retention pane). Nowhere does Han make any such suggestion.

In rejecting claim 20, the Office Action refers to column 3, lines 20-23 of Tsai. This portion of Tsai merely states:

when a scanning device of the present invention is off the work,
some beautiful or meaningful pictures can be placed on the
transparent plate for decoration purposes.

(Tsai, column 3, lines 20-23). However, nothing in this citation to Tsai mentioned anything about an electronic image. At most, this portion of Tsai simply means that a person could place photos on top of transparent plate 32 (and presumably under cover 56) when the scanner was not being used. The assertion that this somehow teaches an electronic image has no basis anywhere in Tsai. Thus, the rejection of claim 20 is improper and should be withdrawn.

H. Claim 31

Claim 31 depends from claim 1 and recites the frame is adapted to selectively receive snap fit covers.

Nowhere does Tsai or Han disclose a picture frame scanner having a frame adapted to selectively receive snap that covers. In rejecting claim 31, the off action simply refers to Figure 4 of Tsai. However, nowhere does Tsai disclose that frame 52 is adapted to receive snap fit covers.

Atty. Dkt. No. 10010566-1

In fact, closer inspection of Figure 4 reveals that the scanner module 38 and transparent cover 56 would both, by themselves, appear to prevent snap fit covers from being mounted to frame 52. Accordingly, the rejection of claim 31 should be withdrawn.

I. Claim 32

Claim 32 depends from claim 31 and recites that the picture frame scanner further comprises a document cover hinged to the frame and operative to cover the display area during scanning.

Neither Tsai nor Han disclose or suggest such an additional document cover. In rejecting claim 32, the office action simply refers to Figure 4 of Tsai. However, Figure 4 of Tsai does not disclose a document cover. Applicants respectfully note that cover 56 has already been characterized as the "support back" in an attempt to reject base claim 1. Transparent cover 56 cannot be characterized as both a support back and the cover.

Although Han may disclose a cover, it would not be obvious to modify Tsai to include such a cover. First, since scanner module 38 faces in an opposite direction as the scanner module in Han, no teaching or suggest exists for providing Tsai with such a cover. Second, since scanner module 38 is on top of frame 52, scanner module 38 would prevent the cover of Han being added to Tsai. Accordingly, the rejection of claim 32 should be withdrawn.

J. Claim 33

Claim 33, as amended, recites a method for scanning an item. The method includes supporting an item to be scanned, generally upright, in a frame on a first side of a transparent pane. The method further includes moving an image scanning bar over the item, wherein the bar is moved on a second side of the first transparent pane between the first transparent pane and a second transparent pane during scanning. Thus, claim 33 and recites a method wherein a scanner bar is moved between two opposite transparent panes during scanning.

Atty. Dkt. No. 10010566-1

Neither Tsai nor Han, alone or in combination, disclose or suggest a method wherein the scanning bar is moved between two opposite transparent panes during scanning. In contrast, when cover 56 of Tsai is positioned opposite to transparent plate 32, scanner module 38 moves over top of both cover 56 and plate 32 during scanning. Thus, claim 33, as amended, overcomes the rejection based upon Tsai and Han.

K. Claim 38

Claim 38 depends from claim 33 and further recites the step of displaying electronic image through the second transparent pane.

Neither Tsai nor Han disclose or suggest a scanner bar that moves between two transparent panes and the displaying electronic image through at least one of the panes. Accordingly, claim 38, as amended, overcomes the rejection based upon Tsai and Han.

L. Claim 42

Claim 42, as amended, recite a system including means for supporting and seating, generally upright, an item to be scanned and displayed such that a lower edge of the item rests upon a means for supporting. Support for the amendment to claim 42 may be found in at least Paragraph [027] which recites:

In operation, a user conveniently slides the photograph or other medium to be scanned into picture frame scanner 100, facing outward, from the top of the scanner. This item is automatically seated into the correct position.

The term "seated" is derived from the word "seat" which means something on which to base an object rests. (The Random House College Dictionary, 1984).

Neither Tsai nor Han disclose or suggest means for seating an item in an upright orientation such that the lower edge of the item rests upon the means for supporting. In contrast, Tsai presumably requires that one position item 34 on plate 32 while in a flat orientation and then

Atty. Dkt. No. 10010566-1

locate cover 56 override them 34 to hold item 34 in place once the scanner is moved to an upright orientation. Tsai discloses nothing upon which a lower edge of item 34 rests when the scanner is in the upright orientation shown in Figure 4. Cover 56 merely contacts a front face, not a lower edge of item 34. Accordingly, claim 42, as amended, overcomes the rejection based upon Tsai and Han.

M. Claim 46

Claim 46 depends from claim 42 and further recites a transparent panel over which the item lies during scanning and means for selectively electronically displaying images through the panel when an item is not overlying the panel.

Neither Tsai nor Han disclose or suggest any means for selectively electronically displaying an image through the transparent panel over which the item lies during scanning. Thus, claim 46, as amended, overcomes the rejection based upon Tsai and Han.

II. Added Claims

With this response, claims 47-51 are added. Claims 47-51 are believed to be patentably distinct over the prior art of record.

A. Claims 47 and 51

Claim 47 depends from claim 1 and further recites a seat configured to engage in lower edge of the item to support the item opposite the display area during scanning while in a generally upright position. Claim 51 depends from claim 33 and recites the step of supporting the item, generally upright such that a lower edge of the item rests upon a seat. Support for such added claims may be found in at least Paragraph [0027] of the present application. Thus, no new matter is believed to be added.

Atty. Dkt. No. 10010566-1

Neither Tsai, Han nor the prior art of record discloses or suggests a seat upon which a lower edge of an item to be scanned rests while in an upright position. Thus, such claims are presented for consideration and allowance.

B. Claims 48 and 49

Claims 48 and 49 depend from claim 15 and further recite the positioning of the scanning bar relative to the support back, the display glass and the retention pain. The prior art of record sales are disclosed these relationships. Accordingly, claims 48 and 49 are presented for consideration and allowance.

C. Claim 50

Claim 50 depends from claim 32 and further recites of the document cover is opaque. The prior art of record fails to disclose the recited document cover, wherein the document cover is opaque. Thus, claim 50 is presented for consideration and allowance.

III. Conclusion

After amending the claims as set forth above, claims 1-26, 30-39 and 42-51 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even

Atty. Dkt. No. 10010566-1

entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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